

REMARKS

Claims 1-112 were pending. Claims 1-65, 76-110 and 112 have been canceled without prejudice. Claims 66-75 and 111 have been amended. New claims 113-133 have been added, which correspond to canceled claims 27, 35-38 and 40-55. Support for these claims can be found throughout the disclosure of the present invention, *e.g.*, in the Specification at p. 8, line 20 to p. 12, line 3; p. 12, line 24 to p. 13, line 26; p. 56, line 5 to p. 92, line 14, and in original claims 27, 35-38 and 40-55 as filed. Therefore, no new matter has been added.

Claims 66-75, 111 and 113-133 are thus currently pending.

In the *Office Action* mailed May 20, 2005, restriction was required to one of the following 81 groups:

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| Group 1 | Claims 1, 4-8, 10-23, 27-31, 35-55 and 67-78, drawn to compounds and uses thereof comprising SEQ ID No. 1, classified in class 424, subclass 1.69. |
| Group 2 | Claims 1, 4-8, 11-23, 27-31, 35-55 and 67-78, drawn to compounds and uses thereof comprising SEQ ID No. 2, classified in class 424, subclass 1.69. |
| Group 3 | Claims 1, 4-8, 10-23, 25, 27-31, 35-55 and 67-78, drawn to compounds and uses thereof comprising SEQ ID No. 4, classified in class 424, subclass 1.69. |
| Group 4 | Claims 1, 4-8, 10-23, 25, 27-31, 35-55 and 67-78, drawn to compounds and uses thereof comprising SEQ ID No. 5, classified in class 424, subclass 1.69. |
| Group 5 | Claims 1, 4-8, 10-23, 27-31, 35-55 and 67-78, drawn to compounds and uses thereof comprising SEQ ID No. 6, classified in class 424, subclass 1.69. |
| Group 6 | Claims 1, 4-8, 10-23, 27-31, 35-55 and 67-78, drawn to compounds and uses thereof comprising SEQ ID No. 7, classified in class 424, subclass 1.69. |

- Group 7 Claims 1, 4-8, 10-24, 27-32, 35-55 and 67-78, drawn to compounds and uses thereof comprising SEQ ID No. 8, classified in class 424, subclass 1.69.
- Group 8 Claims 1, 4-8, 10-24, 27-32, 35-55 and 67-78, drawn to compounds and uses thereof comprising SEQ ID No. 9, classified in class 424, subclass 1.69.
- Group 9 Claims 1, 4-8, 10-23, 27-31, 35-55 and 67-78, drawn to compounds and uses thereof comprising SEQ ID No. 10, classified in class 424, subclass 1.69.
- Group 10 Claims 1, 4-8, 10-24, 27-31, 35-55 and 67-78, drawn to compounds and uses thereof comprising SEQ ID No. 11, classified in class 424, subclass 1.69.
- Group 11 Claims 1, 4-8, 10-24, 27-31, 35-55 and 67-78, drawn to compounds and uses thereof comprising SEQ ID No. 12, classified in class 424, subclass 1.69.
- Group 12 Claims 1, 4-7, 9-23, 26-31, 34-55 and 67-78, drawn to compounds and uses thereof comprising SEQ ID No. 26, classified in class 424, subclass 1.69.
- Group 13 Claims 1, 4-7, 9-23, 26-31, 34-55 and 67-78, drawn to compounds and uses thereof comprising SEQ ID No. 27, classified in class 424, subclass 1.69.
- Group 14 Claims 1, 4-7, 9-23, 26-31, 34-55 and 67-78, drawn to compounds and uses thereof comprising SEQ ID No. 28, classified in class 424, subclass 1.69.
- Group 15 Claims 1, 4-7, 9-23, 26-31, 34-55 and 67-78, drawn to compounds and uses thereof comprising SEQ ID No. 29, classified in class 424, subclass 1.69.
- Group 16 Claims 1-7, 11-23, 27-31, 35-55 and 67-78, drawn to compounds/dimers/multimers/moieties/sequences and uses thereof not encompassed by Groups (1)-(15) above, classified in class 424, subclass 1.69.
- Group 17 Claims 1, 3, 56 and 67-78, drawn to compounds and uses thereof comprising dimer D1, classified in class 424, subclass 1.69.
- Group 18 Claims 1, 3 and 56-78, drawn to compounds and uses thereof comprising dimer D4, classified in class 424, subclass 1.69.

- Group 19 Claims 1, 3 and 56-78, drawn to compounds and uses thereof comprising dimer D5, classified in class 424, subclass 1.69.
- Group 20 Claims 1, 3 and 56-78, drawn to compounds and uses thereof comprising dimer D6, classified in class 424, subclass 1.69.
- Group 21 Claims 1, 3 and 56-78, drawn to compounds and uses thereof comprising dimer D7, classified in class 424, subclass 1.69.
- Group 22 Claims 1, 3 and 56-78, drawn to compounds and uses thereof comprising dimer D10, classified in class 424, subclass 1.69.
- Group 23 Claims 1, 3 and 56-78, drawn to compounds and uses thereof comprising dimer D13, classified in class 424, subclass 1.69.
- Group 24 Claims 1, 3 and 56-78, drawn to compounds and uses thereof comprising dimer D17, classified in class 424, subclass 1.69.
- Group 25 Claims 1, 3 and 56-78, drawn to compounds and uses thereof comprising dimer D24, classified in class 424, subclass 1.69.
- Group 26 Claims 1, 3 and 56-78, drawn to compounds and uses thereof comprising dimer D26, classified in class 424, subclass 1.69.
- Group 27 Claims 1, 3 and 56-78, drawn to compounds and uses thereof comprising dimer D31, classified in class 424, subclass 1.69.
- Group 28 Claims 1, 3 and 56-78, drawn to compounds and uses thereof comprising dimer D32, classified in class 424, subclass 1.69.
- Group 29 Claims 1, 3 and 56-78, drawn to compounds and uses thereof comprising dimer D33, classified in class 424, subclass 1.69.
- Group 30 Claims 79-93 and 95-105, drawn to a method of screening according to independent claim 79 wherein SEQ ID No. 1 is utilized, classified in class 424, subclass 9.2.
- Group 31 Claims 79-93 and 95-105, drawn to a method of screening according to independent claim 79 wherein SEQ ID No. 2 is utilized, classified in class 424, subclass 9.2.
- Group 32 Claims 79-93, 95-105 and 107, drawn to a method of screening according to independent claim 79 wherein SEQ ID No. 4 is utilized, classified in class 424, subclass 9.2.

- Group 33 Claims 79-93, 95-105 and 107, drawn to a method of screening according to independent claim 79 wherein SEQ ID No. 5 is utilized, classified in class 424, subclass 9.2.
- Group 34 Claims 79-93 and 95-105, drawn to a method of screening according to independent claim 79 wherein SEQ ID No. 6 is utilized, classified in class 424, subclass 9.2.
- Group 35 Claims 79-93 and 95-105, drawn to a method of screening according to independent claim 79 wherein SEQ ID No. 7 is utilized, classified in class 424, subclass 9.2.
- Group 36 Claims 79-93 and 95-105, drawn to a method of screening according to independent claim 79 wherein SEQ ID No. 8 is utilized, classified in class 424, subclass 9.2.
- Group 37 Claims 79-93 and 95-106, drawn to a method of screening according to independent claim 79 wherein SEQ ID No. 9 is utilized, classified in class 424, subclass 9.2.
- Group 38 Claims 79-93 and 95-105, drawn to a method of screening according to independent claim 79 wherein SEQ ID No. 10 is utilized, classified in class 424, subclass 9.2.
- Group 39 Claims 79-93 and 95-106, drawn to a method of screening according to independent claim 79 wherein SEQ ID No. 11 is utilized, classified in class 424, subclass 9.2.
- Group 40 Claims 79-93 and 95-106, drawn to a method of screening according to independent claim 79 wherein SEQ ID No. 12 is utilized, classified in class 424, subclass 9.2.
- Group 41 Claims 79-92, 94-105 and 108, drawn to a method of screening according to independent claim 79 wherein SEQ ID No. 26 is utilized, classified in class 424, subclass 9.2.
- Group 42 Claims 79-92, 95-105 and 108, drawn to a method of screening according to independent claim 79 wherein SEQ ID No. 27 is utilized, classified in class 424, subclass 9.2.
- Group 43 Claims 79-92, 95-105 and 108, drawn to a method of screening according to independent claim 79 wherein SEQ ID No. 28 is utilized, classified in class 424, subclass 9.2.

- Group 44 Claims 79-92, 95-105 and 108, drawn to a method of screening according to independent claim 79 wherein SEQ ID No. 29 is utilized, classified in class 424, subclass 9.2.
- Group 45 Claims 79-92 and 95-105, drawn to a method of screening according to independent claim 79 wherein the compounds/dimers/multimers/moieties/sequences and uses thereof are not encompassed by Groups (30)-(44) above, classified in class 424, subclass 9.2.
- Group 46 Claim 109, drawn to a compound as set forth by independent claim 109 (a cyclic polypeptide), classified in class 424, subclass 1.69.
- Group 47 Claim 110, drawn to a compound as set forth by independent claim 110 (a polypeptide), classified in class 424, subclass 1.69.
- Group 48 Claim 111, drawn to a compound as set forth by independent claim 111 wherein the compound is D1, classified in class 424, subclass 1.69.
- Group 49 Claim 111, drawn to a compound as set forth by independent claim 111 wherein the compound is D4, classified in class 424, subclass 1.69.
- Group 50 Claim 111, drawn to a compound as set forth by independent claim 111 wherein the compound is D5, classified in class 424, subclass 1.69.
- Group 51 Claim 111, drawn to a compound as set forth by independent claim 111 wherein the compound is D9, classified in class 424, subclass 1.69.
- Group 52 Claim 111, drawn to a compound as set forth by independent claim 111 wherein the compound is D10, classified in class 424, subclass 1.69.
- Group 53 Claim 111, drawn to a compound as set forth by independent claim 111 wherein the compound is D11, classified in class 424, subclass 1.69.
- Group 54 Claim 111, drawn to a compound as set forth by independent claim 111 wherein the compound is D12, classified in class 424, subclass 1.69.

- Group 55 Claim 111, drawn to a compound as set forth by independent claim 111 wherein the compound is D13, classified in class 424, subclass 1.69.
- Group 56 Claim 111, drawn to a compound as set forth by independent claim 111 wherein the compound is D14, classified in class 424, subclass 1.69.
- Group 57 Claim 111, drawn to a compound as set forth by independent claim 111 wherein the compound is D15, classified in class 424, subclass 1.69.
- Group 58 Claim 111, drawn to a compound as set forth by independent claim 111 wherein the compound is D16, classified in class 424, subclass 1.69.
- Group 59 Claim 111, drawn to a compound as set forth by independent claim 111 wherein the compound is D17, classified in class 424, subclass 1.69.
- Group 60 Claim 111, drawn to a compound as set forth by independent claim 111 wherein the compound is D18, classified in class 424, subclass 1.69.
- Group 61 Claim 111, drawn to a compound as set forth by independent claim 111 wherein the compound is D19, classified in class 424, subclass 1.69.
- Group 62 Claim 111, drawn to a compound as set forth by independent claim 111 wherein the compound is D20, classified in class 424, subclass 1.69.
- Group 63 Claim 111, drawn to a compound as set forth by independent claim 111 wherein the compound is D21, classified in class 424, subclass 1.69.
- Group 64 Claim 111, drawn to a compound as set forth by independent claim 111 wherein the compound is D22, classified in class 424, subclass 1.69.
- Group 65 Claim 111, drawn to a compound as set forth by independent claim 111 wherein the compound is D23, classified in class 424, subclass 1.69.

- Group 66 Claim 111, drawn to a compound as set forth by independent claim 111 wherein the compound is D24, classified in class 424, subclass 1.69.
- Group 67 Claim 111, drawn to a compound as set forth by independent claim 111 wherein the compound is D25, classified in class 424, subclass 1.69.
- Group 68 Claim 111, drawn to a compound as set forth by independent claim 111 wherein the compound is D26, classified in class 424, subclass 1.69.
- Group 69 Claim 111, drawn to a compound as set forth by independent claim 111 wherein the compound is D27, classified in class 424, subclass 1.69.
- Group 70 Claims 1, 3, 11-22, 27-31, 35-55 and 110, drawn to a compound comprising the dimer of claim 112, classified in class 424, subclass 1.69.
- Group 71 Claims 1, 3, 11-22, 27-31, 35-55 and 57, drawn to a compound comprising the dimer of claim 57, classified in class 424, subclass 1.69.
- Group 72 Claims 1, 3, 11-22, 27-31, 35-55 and 58, drawn to a compound comprising the dimer of claim 58, classified in class 424, subclass 1.69.
- Group 73 Claims 1, 3, 11-22, 27-31, 35-55 and 59, drawn to a compound comprising the dimer of claim 59, classified in class 424, subclass 1.69.
- Group 74 Claims 1, 3, 11-22, 27-31, 35-55 and 60, drawn to a compound comprising the dimer of claim 60, classified in class 424, subclass 1.69.
- Group 75 Claims 1, 3, 11-22, 27-31, 35-55 and 61, drawn to a compound comprising the dimer of claim 61, classified in class 424, subclass 1.69.
- Group 76 Claims 1, 3, 11-22, 27-31, 35-55 and 62, drawn to a compound comprising the dimer of claim 62, classified in class 424, subclass 1.69.

- Group 77 Claims 1, 3, 11-22, 27-31, 35-55 and 63, drawn to a compound comprising the dimer of claim 63, classified in class 424, subclass 1.69.
- Group 78 Claims 1, 3, 11-22, 27-31, 35-55 and 64, drawn to a compound comprising the dimer of claim 64, classified in class 424, subclass 1.69.
- Group 79 Claims 1, 3, 11-22, 27-31, 35-55 and 65, drawn to a compound comprising the dimer of claim 65, classified in class 424, subclass 1.69.
- Group 80 Claims 1, 3, 11-22, 27-31, 35-55 and 66, drawn to a compound comprising the dimer of claim 66, classified in class 424, subclass 1.69.
- Group 81 Claims 1, 3, 11-22, 27-31, 35-55 and 67, drawn to a compound comprising the dimer of claim 65, classified in class 424, subclass 1.69.

Applicants hereby elect, with traverse, Group 29, drawn to compounds and uses thereof comprising dimer D33, classified in class 424, subclass 1.69, for prosecution on the merits in the present case. Applicants note that this Group was indicated to include claims 1, 3 and 56-78. As explained in the next section, Applicants respectfully submit that this Group should also include all of claims 66-76, 79, 111 and 113-133 as presently pending.

Applicants further elect the species in which the multimer is D33.

Irrespective of the election made, Applicants respectfully traverse the Restriction Requirement, and respectfully request that it be favorably reconsidered and withdrawn.

A. Groups 28 and 29 Should Be Combined

As an initial matter, Applicants respectfully submit that Groups 28 and 29 are directed to species of similar structure and property, and as such, should be combined into a

single group. Group 28 is directed to compounds and uses thereof comprising dimer D32; Group 29 is directed to compounds and uses thereof comprising dimer D33. This is further confirmed by the recitation in the Restriction Requirement that both Groups 28 and 29 are classified in Class 424, subclass 1.33.

Applicants further note that a search of the subject matter of each of these two Groups would not be a serious burden on the USPTO.

Applicants respectfully submit that a search for compounds and uses thereof comprising D33 would necessarily reveal references that are relevant to compounds and uses thereof comprising D32, and vice versa. This is especially true since each of these two Groups contains compounds having similar structures and properties, so that a search of, for example, the dimer in one Group will yield the dimer of another Group. As such, a comprehensive prior art search can be made under Applicants' proposal without a significant burden on the USPTO, and thus, Applicants' proposal is an appropriate modification of the Restriction Requirement.

As such, Applicants submit that all of pending claims 66-76, 79, 111 and 113-133 should be examined on the merits in the present application. To the extent that some of these claims may not be examined, Applicants also reserve the right to request a rejoinder of all such pending claims, since they ultimately depend from claims 66 and 67, should claims 66 and 67 ultimately be found allowable.

B. The 81-Way Restriction Requirement is Improper

Aside from Applicants' amendments and remarks made above, Applicants submit for the record that the current 81-way Restriction Requirement is improper. The Restriction Requirement appears to have been created by simply making into a separate Group nearly every

possible Sequence identification number and every possible dimer taught in the present Specification. However, no explanation was provided as to why a number of these Groups are distinct from each other.

For example, there is no explanation in the Restriction Requirement as to why a single search of all of structurally similar molecules, *e.g.*, the dimers disclosed in the present invention, together would be a significant burden on the USPTO in light of their similar structures and properties.

Moreover, as a result of the GATT legislation limiting the term of a patent to twenty years from its effective filing date, the delay in the examination of the non-elected claims will likely result in the patent term for those claims being unnecessarily shortened.

Under the present 81-way Restriction Requirement, the USPTO would have to conduct a duplicate, redundant search 81 times for each of those 81 divisional applications. If a different Examiner is assigned to any of the divisional applications, an even more significant loss of USPTO resources and time would be incurred as a result of the examination of those divisional cases. Thus, Applicants respectfully submit that this proposal will result in a significant and unnecessary drain of USPTO resources. Accordingly Applicants respectfully submit that the 81-way Restriction Requirement is improper and should be withdrawn in favor of a Restriction Requirement that keeps all structurally similar species together.

Further, Applicants have observed that Groups 71 through 73, 76 and 78 are redundant because they are directed to compounds listed in claims 57-65, respectively. For example, Group 71 is directed to claims 1, 3, 11-22, 27-31, 35-55 and 57, drawn to a compound comprising the dimer of claim 57. However, the dimer of claim 57 is D1, which is already the subject of group 17. This is also the case with the following: Groups 18 and 72 (dimer D4),

Groups 19 and 73 (dimer D5), Groups 20 and 78 (dimer D6), Groups 23 and 76 (D13) respectively. Therefore, Applicants propose that at the least, Groups 71 through 73, 76 and 78 should be canceled, because they are redundant of Groups 17 through 20 and 23, respectively.

Accordingly, Applicants submit that, if the claims are to be subjected to a restriction requirement, they should be restricted as follows:

- I. Groups 1 through 16 and 30-45 should be combined into one Group, as all of the SEQ. ID Nos are similar in structure and property;
- II. Groups 17-29 and 48-81 should be combined into one Group, as all of the listed dimers are similar in structure and property (with Groups 71-73, 76 and 76 canceled as being redundant of previous Groups, as explained above); and
- III. Groups 46 and 47 should be combined into one Group, as directed to compounds having similar structure and properties (*i.e.*, cyclic polypeptides and polypeptides).

If a telephone interview would be of assistance in the prosecution of this application, the Examiner is invited to telephone Applicants' undersigned attorneys at her convenience at the number provided below.

CONCLUSION

No fees are believed due in connection with the filing of this *Amendment and Response to Restriction Requirement*. However, the Director is hereby authorized to charge any required fees and credit any overpayments to Deposit Account No. 50-0540.

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Respectfully submitted,

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